

REMARKS

In the present application, Claims 1-10, 12, 14-71 and 75-117 are currently pending, and Claims 11, 13 and 72-74 have been canceled by the present amendment. Claim 123 has been added as a new claim. Support for the amendments and new Claim 123 can be found in the specification and drawings of the captioned patent application.

Information Disclosure Statement (IDS)

Applicant would like to thank the Examiner for considering the IDS filed by applicant on November 20, 2003. However, along with the next communication sent by the Office with regard to the captioned application, applicant respectfully requests that the Examiner supply a copy of Form PTO/SB/08A with each reference initialed to confirm that the IDS has been fully considered.

Rejections under 35 U.S.C. §101 and §112

Claims 1-114 stand rejected under these sections as allegedly drawn to non-statutory subject matter. The court in *In re Bilski* (— F.3d —, 88 U.S.P.Q.2d 1385 (2008)) addressed the subject matter eligibility constraints for “process” inventions. The “definitive test,” according to the *Bilski* majority, is that a process is “surely patent-eligible if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.”

Claim 1 is a “system” claim that clearly includes various computer-implemented apparatuses and particular machines that qualify as patent-eligible subject matter under §101. In

any event, and merely to expedite prosecution, Claims 1 and 68 have been amended to clarify the tie to a particular machine or apparatus as required under one prong of the *Bilski* test for “process” inventions. Applicants do not believe that it is necessary at this stage to discuss the applicability of the other prong of the *Bilski* test (i.e., that the invention transforms a particular article into a different state or thing) to the pending claims, but reserve the right to do so at a later time. Claims 2-10, 12, and 14-67 depend from and further limit Claim 1, and Claims 69-71 and 75-113 depend from and further limit Claim 68; these dependent claims are allowable for the same reasons as the independent claim from which each depends. Applicant further submits that Claim 114 is a computer-readable medium claim which qualifies as an article of “manufacture” within the scope of §101.

Claims 115-117 clearly recite a “label product” which applicant submits falls within the ambit of the statutory classes included in §101. For example, a “label product” can be considered an article of “manufacture” within the scope of §101. Applicant submits that subject matter which is a “manufacture” is not required to satisfy the *Bilski* test, which relates primarily to “process” inventions.

Rejections under 35 U.S.C. §102

Claims 1-117 have been rejected under 35 U.S.C. §102(e) for novelty reasons in view of Hart (U.S. Pat. No. 7,048,185).

Among other elements, Hart does not teach, disclose or suggest “further including said data device being configured to generate a label and at least one of a summary report or a service report” or “wherein said label includes at least one electronically readable bar code

portion including data associated with at least one service operation performed on said inspected item” as recited in Claim 1, for example.

Collection of samples for analysis by a laboratory is not specifically taught, disclosed or suggested by Hart. Various embodiments of applicant’s systems are useful for generating and printing labels that are indicative of service operations performed on inspected items. For example, in the context of inspected items which are heavy machines, one embodiment of applicant’s system can be used in association with collecting oil samples during a service operation performed on a machine, generating labels for the oil samples, and transporting the oil samples in containers (to which the generated labels have been applied) to an appropriate laboratory or other service provider for analysis of the oil samples. In its teachings, Hart simply does not address this label generation aspect of the present claims which is useful for fluid sample collection and transportation, for example.

Claims 68, 114 and 115 are likewise distinguishable from Hart for the same reasons as Claim 1. Claims which depend from Claims 1, 68, 114 and 115 are allowable for at least the same reasons as the independent claim from which each depends.

Miscellaneous

Applicant submits that the dependent claims pending herein are allowable at least by virtue of their dependency on independent claims which, as applicants describe above, are patentable over the cited references. Applicant reserves the right, however, to make supplemental arguments as may be necessary, because the dependent claims of the present application include additional features that further distinguish the claims from the cited

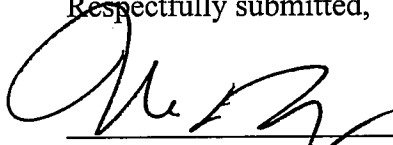
references. A detailed discussion of these distinctions is believed to be unnecessary at this time in view of the fundamental distinctions already set forth above with respect to the independent claims.

SUMMARY

In view of at least the foregoing remarks and amendments, applicant requests reconsideration and withdrawal of the rejections set forth in the Office Action. Allowance of the pending claims is requested.

Any questions regarding the present response are invited to the attention of the undersigned representative by telephone or e-mail.

Respectfully submitted,



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